

26 AUG 2003

#7



UNITED STATES PATENT and TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. Box 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Steven J. Trzaska
Cognis Corporation
2500 Renaissance Blvd.
Suite 200
Gulph Mills, PA 19406

In re Application of :
SCHMID, Karl Heinz et al. :
US Application No.: 10/088,731 : DECISION ON
PCT Application No.: PCT/EP00/08960 :
Int. Filing Date: 14 September 2000 : REQUEST UNDER
Priority Date: 23 September 1999 :
Attorney's File Reference: C 2079 PCT/US : 37 CFR 1.497(d)
For: COSMETIC AND/OR :
PHARMACEUTICAL PREPARATIONS :
CONTAINING DICARBOXYLIC ACID :
MONOESTERS :

This is a response to applicant's "REQUEST FOR CORRECTION OF INVENTORSHIP" filed 14 July 2003 which is being treated as a request under 37 CFR 1.497(d) to add Josef Koester (Koester) as an inventor. The \$130 fee under 37 CFR 1.497(d)(2) and 1.17(i) has been paid.

BACKGROUND

On 02 June 2003, this Office mailed a decision dismissing applicant's request under 37 CFR 1.497(d) to add Josef Koester (Koester) as a co-inventor. The decision stated that the applicants were required to submit a written consent of assignee Cognis Deutschland GMBH & Co. KG (Cognis) in accordance with 37 CFR 1.497(d)(3).

On 14 July 2003, applicants filed the present "REQUEST FOR CORRECTION OF INVENTORSHIP" which is accompanied by, inter alia, a "CONSENT OF ASSIGNEE UNDER 37 CFR 1.497(d)(3)" signed by Bernd Fabry (Fabry), Director of IP at Cognis.

DISCUSSION

37 CFR 3.73(b) states:

b)(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

Further, part II of MPEP section 324 under the heading "ESTABLISHING OWNERSHIP" states:

When an assignee first seeks to take action in a matter before the Office with respect to a patent application, patent, or reexamination proceeding, the assignee must establish its ownership of the property to the satisfaction of the Commissioner. 37 CFR 3.73(b). The assignee's ownership may be established under 37 CFR 3.73(b) by submitting to the Office, in the Office file related to the matter in which action is sought to be taken:

(A) documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment submitted for recording); or

(B) a statement specifying, by reel and frame number, where such evidence is recorded in the Office.

Documents submitted to establish ownership may be required to be recorded as a condition to permitting the assignee to take action in a matter pending before the Office.

The action taken by the assignee, and the 37 CFR 3.73(b) submission establishing that the assignee is the appropriate assignee to take such action, can be combined in one paper.

The establishment of ownership by the assignee must be submitted prior to, or at the same time as, the paper requesting or taking action is submitted. 37 CFR 3.73(c). If the submission establishing ownership is not present, the action sought to be taken will not be given effect. If the submission establishing ownership is submitted at a later date, that date will be the date of the request for action or the date of the assignee's action taken.

The submission establishing ownership by the assignee must be signed by a party who is authorized to act on behalf of the assignee. See discussion below. Once 37

CFR 3.73(b) is complied with by an assignee, that assignee may continue to take action in that application, patent, or reexamination proceeding without filing a 37 CFR 3.73(b) submission each time, provided that ownership has not changed.

The submission establishing ownership by the assignee pursuant to 37 CFR 3.73(b) is generally referred to as the "statement under 37 CFR 3.73(b)" or the "37 CFR 3.73(b) statement." A duplicate copy of the 37 CFR 3.73(b) statement is submitted. See 37 CFR 1.4(b) and MPEP § 502.04.

Applicants are required to submit the 37 CFR 3.73(b) statement establishing ownership by the assignee Cognis.

CONCLUSION

For the above reasons, applicants request for the addition of Koester as a co-inventor is **DISMISSED** without prejudice.

If reconsideration on the merits of this request is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Request Under 37 CFR 1.497(d)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response to this decision will result in ABANDONMENT of the application.

Any further correspondence with respect to this matter deposited with the United States Postal Service on or after May 1, 2003 should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



Diana L. Oleksa
Special Programs Examiner
PCT Special Programs Office
Telephone: 703-308-0890

Leonard Smith
PCT Legal Examiner
PCT Legal Office